

No. 14800

IN THE

United States Court of Appeals

FOR THE NINTH CIRCUIT

FRANCES P. SYRACUSE and NEW WONDER BAG CORPORATION,

Appellants,

vs.

HARRY PARIS, *et al.*,

Appellees.

APPELLANTS' REPLY BRIEF.

FILED

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DEC 21 1955

PAUL P. O'BRIEN, CLERK

TOPICAL INDEX

	PAGE
Patent Office cited best art.....	5
Appellee's inadequate proof.....	6
Invention	7
Exhibit X	9
Summary judgment on facts without trial is irregular and invalid	13
Infringement	15
Conclusion	16

TABLE OF AUTHORITIES CITED

CASES	PAGE
Adler Sign Letter Co. et al. v. Wagner Sign Service, Inc., 112 F. 2d 264.....	6
Bankers Utility Co. v. Pacific Nat'l Bank, 18 F. 2d 16.....	14
Diamond Rubber Co. v. Consol. Tire Co., 220 U. S. 428.....	5
Electro Mfg. Co. v. Yellin, 56 U. S. P. Q. 290, 132 F. 2d 979....	12
Hycon Mfg. Co. v. H. Koch & Sons, 104 U. S. P. Q. 231.....	13
Leeds & Catlin v. Victor Talking Machine Co., 213 U. S. 318....	5, 11
Loom Co. v. Higgins, 105 U. S. 591.....	4
Reckendorfer v. Faber, 92 U. S. 347, 23 L. Ed. 719.....	13
The Detroit Motor Appliance Co. v. Burk, 4 F. 2d 118.....	5, 6
Toledo Computing Scale v. Moneyweight Scale Co., 178 Fed. 557	14

TEXTBOOKS

Amdur, Patent Law and Practice, Sec. 16, p. 15.....	14
1 Walker on Patents (Deller's Ed.), Sec. 13, p. 52.....	15
1 Walker on Patents (Deller's Ed.), Sec. 63.....	6

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On the first page of Appellee's Brief the attention of this Honorable Court is directed to the so-called technical error of the appellee's counsel and the lower court in proceeding to summary judgment on the defendant's motion therefor, in view of the fact that the patent in suit is not in the Transcript of Record, and for the record counsel for appellee contends that appellants' appeal should be arbitrarily dismissed in favor of the appellee, in view of said technical error of the appellee's counsel.

The position of the defendant's counsel, as to the legal effect of his self-serving declaration "that the patent in suit is not in the transcript of Record," is without merit and is untenable and particularly in this suit in *equity*. The motion for summary judgment was the motion of

counsel for defendant, and he is responsible for it and for any damage suffered by plaintiffs by reason of the defendant's attorney's gumming up of the case by proceeding with his grossly irregular motion, which necessitated the prosecution of this appeal by appellants. The suggestion of counsel for appellee that this Court, if it desired to be technical, could dismiss appellants' meritorious appeal on the sole ground that he does not find the patent in suit in the Transcript of Record, flies directly in the face of the Transcript of Record, Certificate of Clerk, page 31, as follows:

“Defendant's Counter Designation of Additional Contents of Record;

which, together with the Deposition of Frances P. Syracuse, taken on July 28, 1954, at Los Angeles, California, deft's exhibit C; *File wrapper and contents of patent in suit*; all in said cause, constitute the *transcript of record on appeal* to the United States Court of Appeals for the Ninth Circuit.

I further certify that my fees for preparing and certifying the foregoing record amounted to \$1.60, which sum has been paid by appellant.

Witness my hand and the seal of said District Court, this 28th day of June, 1955.

[Seal]

JOHN A. CHILDRESS,

Clerk.

By /s/ CHARLES E. JONES,
Deputy.”

The said Transcript of Record and appeal are endorsed and Filed June 29, 1955, by

“/s/ PAUL P. O'BRIEN,
*Clerk of the United States Court of Appeals
for the Ninth Circuit.”*

In a letter addressed to the Clerk of the United States District Court, Southern District of California, Central Division, dated June 27, 1955, by counsel for defendant, said counsel filed therewith "*Ex. B. File wrapper and contents of the patent in suit.*" No copy of said letter and file wrapper were served on counsel for appellants, to his knowledge, but said letter appears in the file of the case with the United States District Court Clerk of this district.

The file wrapper and contents of the patent in suit generally contains a *certified copy of said patent*, and it should be in said file wrapper and contents, which the Clerk of the District Court has certified, and constitutes a part of the Transcript of Record on appeal to this Court. However, appellants' attorney has a certified copy of the file wrapper and contents of the patent in suit, including said patent, and, if necessary, will offer it in evidence, *nunc pro tunc*, at the hearing of this appeal, so that this Court may consider the motion for summary judgment in the District Court as a trial, and hear this appeal on the full merits of the case.

Moreover, it should not be overlooked by this Honorable Court that the jurisdiction of the United States District Court is admitted by the defendant Harry Paris, by his motion for summary judgment, and is admitted by said District Court by its Findings of Fact and Conclusions of Law, and by the Summary Judgment of said Court. (See Appellants' Op. Br. pp. 1-2.)

There is something mysterious about the patent in suit, in view of the fact that it disappeared under rather suspicious circumstances. When this suit was brought, the plaintiff, appellant Frances P. Syracuse, had her original Letters Patent in suit No. 2,533,850, and she gave it to

her attorney, at that time, Robert E. Geauge. Counsel for defendant, however, borrowed said letters patent from Mr. Geauge, but has never returned it, and plaintiffs' present counsel has never been able to obtain it, although he has tried to do so, and the defendant's counsel, if he is to be believed, presented his motion for summary judgment to the Court and obtained said judgment without knowing, and without the Court knowing, that the patent in suit was not before the Court. It is incredible that the District Judge could consider the defendant's motion seriously on its merits and judge the same without knowing what he was judging. The position of the defendant's counsel that, because he muffed his motion for summary judgment, by leaving out of his motion the subject matter of the litigation, this Honorable Court should nevertheless dismiss the appellants' appeal, is a *reductio ad absurdum*, and leaves this Honorable Court with no alternative other than to reverse the summary judgment of the District Court for irregularity, and adjudicate the patent in suit valid and infringed by the defendant, and order an accounting of damages against the defendant in favor of the plaintiffs for such infringement. Defendant has had his day in court so far as the lower court is concerned.

The summary of the prior art patents by defendant's counsel on page 9 of his brief, to the effect that everything in the claim of the patent in suit is old in handbags, is no bar to patentability of the *new combination of old elements of the patent in suit, which performs a new and useful function and accomplishes a new and useful result.*

Loom Co. v. Higgins, 105 U. S. 591.

“A *combination* is a union of elements which may be partly old and partly new, or wholly old or wholly new. But whether new or old, the combination is a means—an invention—distinct from them (the elements) . . . In making the combination an inventor has the whole field of mechanics to draw from.”

Leeds & Catlin v. Victor Talking Machine Co.,
213 U. S. 318, quoted in *Diamond Rubber Co.*
v. Consol. Tire Co., 220 U. S. 428.

Patent Office Cited Best Art.

The contention of counsel for defendant that the examiner in the Patent Office overlooked any pertinent art in his examination of the application for the patent in suit, is without merit and certainly farfetched. In fact, the additional patents set up by the defendant in his Amended Answer are not so close to the patent in suit as the prior art patents cited by the Patent Office against the application for the patent in suit, and particularly the patent of Holland, No. 2,447,940, which was cited by the Patent Office in the prosecution of the application for the patent in suit. *The presumption is against the contention of the defendant's counsel that the Patent Office did not cite the most pertinent prior art against the application for the patent in suit.*

“The presumption is that the officials of the Patent Office did their duty, and considered other patents *now brought forward as new prior art*. There is no evidence *dehors* these patents, nor is there anything in the patents themselves which in my judgment should overthrow the presumption.”

The Detroit Motor Appliance Co. v. Burk, 4 F.
2d 118.

See also:

Adler Sign Letter Co. et al. v. Wagner Sign Service, Inc., 112 F. 2d 264 (citing above *Detroit Motor Appliance v. Burk, supra*, Appellants' Op. Br. p. 26).

The prior art which the defendant's attorney alleges was overlooked by the Patent Office examiner in his examination of the application for the patent in suit, consists of five patents contained within a folder marked Defendant's Exhibit "C", which additional prior art was found in an *unofficial* search in the Patent Office by a Washington associate attorney employed by counsel for defendant, and there is no showing whatever that said Washington associate was any better qualified to determine the novelty of an invention than any examiner in the Patent Office who is particularly experienced in the class of inventions which he is employed to examine, and the *presumption of novelty and validity of the patent* in suit is certainly not overthrown by the additional prior art patents found in an *unofficial* search by an outside Washington associate attorney.

Appellee's Inadequate Proof.

The defense of invalidity of the patent in suit rests, in the last analysis, solely on the uncorroborated affidavit of the defendant's counsel, C. G. Stratton [Tr. pp. 12-13], which *affidavit was insufficient to overthrow the strong presumption of validity* of the patent in suit and to prove invalidity of said patent *beyond a reasonable doubt* according to the applicable rule of evidence.

Walker on Patents (Deller's Ed.), Vol. One, Sec. 63.

Invention.

The crude attempt of counsel for defendant to negative the novelty, invention and patentability of the patent in suit, on additional prior art found on an *unofficial* investigation, which additional art is nothing more than *cumulative* art, is without merit, in view of the fact that said prior art fails to disclose the *inventive concept of the invention of the patent in suit*, to wit: a *narrow hand bag for mothers and nurses of infants*, in which two longitudinal vertical diaper compartments are formed in the bag, which compartments are divided by a longitudinal waterproof partition there between, and a pair of *end nursing bottle compartments* at the *ends, respectively*, of said diaper compartments, divided from said diaper compartments by waterproof partitions, which diaper compartments and bottle compartments are *detachably closed*, by detachable *slide fasteners*, or *zippers*, respectively, *opening at the outside of said compartments*, so that *any one of said compartments may be opened to provide access thereto without opening any other of said compartments*, thus providing a *narrow, compact and not bulky handbag, which may be conveniently and easily carried by a mother or a nurse while carrying an infant, and which handbag may be very easily operated to open any one of the diaper compartments or bottle compartments, respectively, without opening any of said other compartment, and which bag is neat and attractive in appearance, which inventive concept of the patent in suit is responsible for the unusual sales and commercial success of the appellants' nursing hand bag, which has displaced on the market all other handbags of the prior art, which, so far as appellants know, are not on the market and have not been commercially successful, and there is no proof otherwise to the contrary.*

The prior art patents which were not cited by the Patent Office have been considered on pages 22-25 of Appellants' Opening Brief, and counsel for appellants sees no reason for changing his analysis and opinion of said prior art patents, after reading Appellee's Brief, other than to emphasize his opinion that the *Patent Office cited the best art* against the application for the patent in suit, *which art* cited by the Patent Office *is more pertinent* to the patent in suit than any of the prior art patents found by counsel for appellee in an *unofficial* search of the Patent Office, which last named patents the Patent Office did not cite against the patent in suit and are incorrectly alleged by counsel for defendant to have been overlooked by the Patent Office.

Brief comment, however, will be made on said prior art patents which counsel for defendant alleges are more pertinent to the patent in suit than the patents cited by the Patent Office, and which first named patents counsel for defendant alleges were *overlooked* by the Patent Office. The self-serving declaration of counsel for defendant (appellee) that the Patent Office overlooked the best art in examining the patent in suit is uncorroborated by any *expert witness under oath*.

The Shanzer design patent, Des. 147,477 is *falsely assumed by counsel for defendant to be identical* to the patent in suit, but it will be noted that the Shanzer patent has only *one* diaper compartment with *one* zipper extending longitudinally of the bag, as shown in Figure 3 of the Shanzer patent drawing, while the handbag of the patent in suit has *two longitudinally diaper compartments 33 and 34 divided by a waterproof partition 32* (Fig. 2 of patent drawing) which compartments are detachably closed at their upper sides by *two* zippers 23 and 24, re-

spectively. (Figs. 1, 2 and 4 of patent drawing.) Compartment 33 (Fig. 2) may contain *clean* diapers and the other compartment 34 may contain *damp, soiled diapers*, and the *waterproof partition* 32 (Fig. 2) prevents the *damp, soiled diapers* in compartment 33 *from soiling the clean diapers* in the compartment 34. In the Shanzer patent with only *one* diaper compartment there is *no moisture proof partition* between *two diaper compartments* to *prevent soiling of clean diapers by damp, soiled diapers*. The handbag of the patent in suit, in protecting the clean diapers from being soiled by the soiled diapers, *performs a new and useful mechanical function* which *cannot be performed by the Shanzer design patent*, and the *patent in suit thus has an expanded utility* which the Shanzer *design* patent does not have. The Shanzer patent *does not perform the mechanical function* of the patent in suit, and consequently, the Shanzer *design* patent is no anticipation of the *mechanical* patent in suit. The owner of the Shanzer patent handbag does not manufacture said Shanzer handbag, but like the defendant Harry Paris in this suit, said owner of said Shanzer patent manufactures the plaintiffs' patent handbag, without license of plaintiffs and infringes the plaintiffs' patent while this suit is pending. It is the contemptible practice of wilful infringers like the defendant herein to extol the virtues of the prior art, without using the prior art, while using and infringing the plaintiffs' patent.

Exhibit X.

The argument of defendant's counsel that Plaintiffs' Exhibit X (handbag) was introduced to show that the Shanzer patent is invalid, is an attempted distortion of the purpose and significance of said exhibit by counsel for defendant. Said Exhibit X shows a handbag of sub-

stantially the *same shape and design* as the Shanzer handbag with a *single* compartment and zipper extending *longitudinally of the upper side of the bag*, and end zippers extending downwardly from the upper side in the ends, respectively, of the bag, substantially in the same manner as in the Shanzer patent. In other words, said Exhibit X anticipates every *design feature* of the Shanzer patent, except the two bows at diagonal corners of the bag, *which bows are not included in and are no part of the handbag of the patent in suit*. Every *design feature* of the Shanzer bag which may correspond to design features of the patent in suit, were included in Plaintiffs' Exhibit X about *ten years before the application for the Shanzer patent* was filed, and consequently said *corresponding design features in the Shanzer patent and the patent in suit were in the public domain* long before the applications for the Shanzer patent and the patent in suit were filed. To set up the Shanzer patent as an anticipation of common *design features* in said Shanzer patent and the patent in suit *when said design features were in the public domain is a reductio ad absurdum*. On the other hand to set up the Shanzer patent as an anticipation of the *mechanical function* of the patent in suit of the means in said patent to prevent soiled diapers in one compartment from contacting and soiling clean diapers in another compartment, is another *reductio ad absurdum* in view of the fact that the *Shanzer patent has no means or two separate diaper compartments to prevent soiled diapers in one compartment from contacting and soiling clean diapers in another compartment*. The fact that the *common design features of both the Shanzer patent and the patent in suit were in the public domain*, and the fact that the *mechanical function* of the patent in suit of the mechanical means, to wit: the diaper compartments and

the moisture proof partition there between, for preventing contract with and soiling of the clean diapers by the damp, soiled diapers, are not included in and are not part of the Shanzer patent, *eliminates said Shanzer patent as a valid prior art reference against, and as an anticipation of the patent in suit.* Said Shanzer patent consequently, *should be disregarded as prior art altogether against the patent in suit,* despite the false assertion of counsel for defendant that the Shanzer patent is probably the *closest prior patent* to the patent in suit and was overlooked by the Patent Office in the examination of the application of the patent in suit. Moreover, the additional assertion of counsel for defendant that, in view of said irrelevant Shanzer patent, “the *prima facie* presumption of validity of the patent in suit is believed to be entirely gone,” *is another reductio ad absurdum* of counsel for defendant. There are obviously a number of screws loose in the logic of the argument of counsel for the defendant. The fact that the common *design features* of the Shanzer patent and the patent in suit, *which are the only common features* of said two patents, were in the *public domain* when the application for the patent in suit was filed, in view of Plaintiffs’ Exhibit X, gave the appellant-patentee, Frances P. Syracuse, the right to include said common design features in the *new combination* claim of the patent in suit, since an applicant for patent has a right to claim a *new combination of old elements*.

*Leeds & Cattlin v. Victor Talking Mach. Co.,
supra.*

The citation of authorities by the defendant’s counsel that a *design* patent may anticipate a *mechanical* patent, are not in point, in this case, in view of the fact that

the Shanzer patent does not show the *two* zippers for the two adjacent diaper compartments and the moisture-proof partition between said compartments for the purpose described.

“Of course anticipation of a *mechanical patent* is not established by a *design patent which does not disclose the structure* of the mechanical patent.”

Electro Mfg. Co. v. Yellin (C. C. A. 7), 56 U. S. P. Q. 290, 292, 132 F. 2d 979.

As for the remaining patents found in an *unofficial* search and offered by the defendant's counsel, which he has alleged were overlooked by the Patent Office, contrary to legal presumption, it will be noted that not one of said remaining patents shows a *narrow bag with two zipper-closed laterally-spaced diaper compartments*, and *two zipper-closed end bottle compartments at the ends respectively* of said bag, as in the patent in suit. Moreover, the Gale patent No. 1,617,629, Halpin patent No. 2,025,101 and the Vasquez patent No. 2,429,856 are entirely *too wide and too bulky* for a handbag of the type of appellant's handbag, which has to be carried by a mother or nurse while carrying an infant which has to be nursed by using appellants' handbag.

We are not aware, and there is no evidence that any of the bags of the prior art were ever used, or used as a *portable infant's nursing bag* like appellants' nursing bag, the commercial success of which was immediate when it appeared on the market and displaced other handbags used for the same purpose as appellants' patented bag, which facts appellants are prepared to prove.

Summary Judgment on Facts Without Trial Is Irregular and Invalid.

The statement on page 12 of Appellee's Brief that "*No disputed issues of fact were raised by said affidavits,*" on motion for summary judgment is rather extraordinary in view of the obvious fact that said motion was based on the defense of *alleged anticipation by the prior art* of the patent in suit.

"*Anticipation by the prior art is a question of fact. Thompson Spot Welder Co. v. Ford Motor Car Co., 265 U. S. 445, 44 S. Ct. 533, 68 L. Ed. 1098; Reinharts Inc. v. Catapillar Tractor Co., 9 Cir., 85 F. 2d 628, certiorari denied 302 U. S. 694, 58 S. Ct. 13, 82 L. Ed. 536.*"

Counsel for defendant misconstrue the case of *Hycon Mfg. Co. v. H. Koch & Sons* (C. A. 9), 104 U.S. P. Q. 231, as applied to the present case by the Court of Appeals of this circuit as follows:

"The trial court exceeded the permissible limits of determination of disputed facts, questions without trial. . . . An indispensable prerequisite to such a summary judgment, is the absence of a material fact."

The authorities cited by counsel for defendant on pages 4, 5 and 10 of Appellee's Brief are not in point. The case of *Reckendorfer v. Faber*, 92 U. S. 347, 23 L. Ed. 719, is an old case which has not been followed by later cases. The ruling in said case erroneously treated the patent for a pencil with a rubber on one end of the pencil as a *machine* in which the elements of the machine co-act according to the inherent rule of action of the machine, but said patent for the pencil and rubber for erasing was

not a patent for a machine, but was a patent for an *article of manufacture*, like the patent in suit for a nursing handbag, which has no inherent rule of action of its own, but requires the application of external force to govern its operation and utility.

The validity of the patent in suit comes clearly within the following definition of Amdur, Patent Law and Practice, page 15, Section 16:

“A manufacture or article of manufacture is an assemblage of parts (or a single homogeneous unit) *passively* useful in reaching a beneficial result. It differs from a machine in having no inherent law of operation.”

Examples of articles of manufacture are wooden pavements, collar buttons, barbed wire, railway brake shoes and belt for driving machinery.

In *Toledo Computing Scale v. Moneyweight Scale Co.*, 178 Fed. 557 at 563, the Court held:

“*It is significant that very few combinations of old devices* have been held void for aggregation. The fact that this machine was the first to be commercially successful should also have some favorable influence on the matter of construction.”

The case of *Bankers Utility Co. v. Pacific Nat'l Bank*, 18 F. 2d 16 at 18, the Court (C. C. A. 9) held:

“In their position plaintiffs are fortified by the presumptions attending a patent (*Wilson & Willard Mfg. Co. v. Bole Bole* (C. C. A.), 227 F. 607; *San Francisco C. Co. v. Beyrle* (C. C. A.), 195 F. 516) and by the fact that their device is a commercial success and has brought on imitation (*Application of Me-Clair* (D. C.), 16 F. (2d) 351; *Sandusky v. Brooklyn Box Toe Co.* (D. C.), 13 F. (2d) 241;

Carson v. Am. Smelting Co. (C. C. A.), 4 F. (2d) 463; Murphy Wall Bed Co. v. Rip Van Winkle Wall Bed Co. (D. C.), 295 F. 748, etc.).”

“The term ‘manufacture,’ as used in the patent law, has a very comprehensive sense, embracing whatever is made by the art or industry of man, *not being a machine, a composition of matter, or a design.*”

Walker on Patents (Deller’s Ed.), Vol. One, p. 52, Sec. 13.

Infringement.

Counsel for appellee has asserted that the claim of the patent in suit is an unduly narrow claim, which the appellee’s handbag does not infringe, but the scope of the claim is immaterial when the infringer has copied said claim closely, which the appellee has done in the case at bar. A comparison of the defendant’s handbag, Plaintiffs’ Exhibit “B” for identification, Deposition of Appellee Harry Paris, pages 10, 13 and 55, with the claim of the patent in suit, shows that said claim reads, element for element upon the elements, respectively, of appellee’s handbag. Moreover, said appellee’s handbag, Plaintiffs’ Exhibit “B” for identification, is a “Chinese” copy of appellants’ handbag, Plaintiffs’ Exhibit “A” for identification, Deposition of Harry Paris, pages 3, 8 and 9. Appellants have clearly proved a clear case of infringement of their patent in suit against the appellee.

On page 11 of Appellee’s Brief the appellee is described as a small, impecunious business man who has been unduly oppressed by the appellants with the present litigation, but we have a financial report of Dun & Bradstreet, Inc. on the appellee, Harry Paris, which shows that

said appellee's net sales of appellants' patented handbag during the year 1952 amounted to \$100,000, with a net profit of \$20,000. Said net sales of \$100,000 included sales to Sears, Roebuck stores of appellants' patented handbag, which sales appellants should have under protection of their patent in suit. Appellee during the years 1954 and 1955 bought two houses valued at \$32,000 and \$34,000, respectively, which houses have a rental income of \$820 monthly. Appellee has been in Europe since September last, and has returned to Los Angeles and started another business. Evidently the appellee, Harry Paris, is the "poor little rich boy."

Conclusion.

The summary judgment of the lower court should be reversed. The patent in suit should be adjudicated valid, and infringed by said appellee. A permanent injunction should issue against the appellee enjoining him from further infringement of the appellants' patent in suit. The Court should order an accounting for damages against appellee in favor of appellants for infringement by appellee of the appellants' patent in suit. And the Court should award costs and disbursements of this suit and an attorney's fee to appellants, and such other and further relief to appellant as to the Court may seem proper.

ALAN FRANKLIN,

Attorney for Appellants.

Dated: Los Angeles, California,
December 23, 1955.